

REMARKS

Upon amendment, Claims 1-13, 15 and 19 are pending in this application. Claims 1-13 have been amended to more clearly define the subject matter to be claimed. Support for these amendments can be found throughout the specification, with particular regard to the disclosed examples. No new matter has been added.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the objections to and the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is in condition for allowance.

Priority Claim

The Examiner has acknowledged the Applicants' claim for priority to four German applications and a PCT International Application. The Examiner states that no English Translations of these applications have been filed as required by 35 U.S.C. 119(b).

Applicants note that certified copies of each of the priority applications were submitted to the Office on December 2, 2004. Furthermore, Applicants' note that an English translation is not required under 35 U.S.C. 119(b) (See, 37 C.R.F. 1.55(4)). Nevertheless, while Applicants are not in possession of English translations of the priority documents at this time, if the Examiner is specifically requesting such English translations, Applicant's will endeavor to procure them in due course.

Rejections under 35 U.S.C. §112 , first paragraph

Claims 1-11 and 15 are rejected under 35 U.S.C. 112, First Paragraph, as allegedly failing to comply with the enablement requirement, particularly with respect to the enablement of solvates. While Applicants strongly disagree with the Examiner's allegation, and solely for the

purpose of advancing prosecution, Claims 1-11 and 15 have been amended to recite “a salt thereof” instead of “a solvate, a salt, or a solvate of a salt thereof.” Support for these amendments can be found throughout the originally-filed application, including the specification, examples and claims.

Claims 1-11 and 15 are also rejected under 35 U.S.C. 112, First Paragraph, as allegedly failing to comply with the enablement requirement, particularly with respect to the enablement of the variable E and R⁴.

Specifically, the Examiner states that with regard to the variable E, “the specification, while being enabling for E being C≡C and arylene where arylene is phenyl and heteroarylene where heteroarylene is pyridinyl, pyrimidinyl, thiophenyl, pyrrolyl, oxadiazolyl, but does not reasonably provide enablement for E being all arylene and heteroarylene chemical moieties.”

While Applicants strongly disagree with the Examiner’s allegation, and solely for the purpose of advancing prosecution, Claim 1 has been amended to recite E is C≡C, phenylene, thienylene, oxadizolylene, pyrrolylene, furanylene, pyrimidinylene, or pyridinylene. Claims 2-11 and 15 have been amended accordingly. Support for these amendments can be found throughout the originally-filed application, including the specification, examples and claims.

With regard to the variable R⁴ the Examiner states that the specification, “does not reasonably provide enablement for R4 being all claimed heterocyclylcarbonyl, heterocyclylcarbonylamino, heteroaryl amino and heterocyclyls.”

While Applicants strongly disagree with the Examiner’s allegation, and solely for the purpose of advancing prosecution, Claim 1 has been amended to recite:

R⁴ is hydrogen, halogen, cyano, amino, trifluoromethyl, trifluoromethoxy, C₁-C₆-alkyl, C₁-C₆-alkylcarbonyl, C₁-C₆-alkylamino, formyl, hydroxycarbonyl, C₁-C₆-alkoxy, C₁-C₆-alkoxycarbonyl, C₁-C₆-alkylthio, C₁-C₆-alkylcarbonylamino, C₁-C₆-alkylaminocarbonyl, C₁-C₄-alkylsulphonylamino, C₃-C₈-cycloalkylcarbonyl-

amino, C₃-C₆-cycloalkylaminocarbonyl, pyrrolyl, C₁-C₆-alkylaminocarbonylamino, hydroxyl, phenyl morpholinyl, oxypiperidinyl, oxopyrrolidinyl, oxomorpholinyl, pyrrolidinyl, morpholinylcarbonyl, piperidinyl, pyridinyl, dihydropyrrolylcarbonyl, C₁-C₆-alkylpiperizinylcarbonyl, isoxazolecarbonylamino, tetrahydrofuranylcabonylamino, furoylamino, piperidinylcarbonyl, or piperidinylcarbonyl ,

where C₁-C₆-alkyl may optionally be substituted by hydroxyl, cyano, amino, C₁-C₆-alkylaminocarbonylamino, C₁-C₆-alkylaminocarboxyl, morpholinyl or aryl,

C₁-C₆-alkylaminocarbonyl may optionally be substituted by C₁-C₆-alkoxy or C₁-C₆-alkylamino, and

C₁-C₆-alkylcarbonylamino may optionally be substituted by C₁-C₆-alkoxy.

Claims 2-11 and 15 have been amended accordingly. Support for these amendments can be found throughout the originally-filed application, including the specification, examples and claims.

As such, Applicants respectfully request withdrawal of the rejections to the instant claims under 35 U.S.C. 112.

Rejections under 35 U.S.C. § 103(a)

Claims 1-9 and 15 are rejected under 35 U.S.C. 103(a) as allegedly obvious in light of copending application No. 10/500,096 which corresponds to PCT International Application Publication WO 2003/055878 filed December 16, 2002 (“the ‘096 Application” and “the ‘878 Publication,” respectively). The Examiner has not specified which section of 35 U.S.C. 102 the ‘096 Application is alleged to qualify under.

Applicants note that the ‘878 Publication was published on July 10, 2003.

As such, the '878 Publication was not published until after the PCT International Application from which the instant application claims priority to (i.e. PCT/EP03/05735, filed June 2, 2003). Thus, the '096 Application does not qualify as prior art under 35 U.S.C. 102(a).

Similarly, the '878 Publication was published less than one year before the PCT International Application from which the instant application claims priority to. As such, the '096 Application does not qualify as prior art under 35 U.S.C. 102(b).

At best, the '096 Application could qualify as prior art under 35 U.S.C. 102(e) as of its date of publication. **However**, Applicants note that the '878 Publication was published **in German**. As such, the '878 Publication is not entitled to a 102(e) date under the provisions of the AIPA.

As such, the '096 Application also does not qualify as prior art under any section of 35 U.S.C. 102.

As the '096 Application does not qualify as prior art under 35 U.S.C. 102, the '096 Application also does not qualify as prior art under 35 U.S.C. 103. As such, Applicants respectfully request withdrawal of all prior art rejections to the instant claims.

Provisional Rejections for Non-Statutory Double Patenting

Claims 1-9 and 15 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over Claims 1-6, 11, 16-21 and 23 of copending Application No. 10/500,096.

Applicants do not agree with the rejection. Nevertheless, Applicants request an abeyance of the provisional double patenting rejecting until such time that allowable subject matter is known in the present application at issue. If necessary, Applicants will consider filing a Terminal Disclaimer to overcome the rejection.

CONCLUSION

In view of the foregoing remarks presented herein, reconsideration and withdrawal of all election requirements and allowance of the instant application with all pending claims are respectfully solicited. If a telephone conversation with Applicants' attorney(s) would help to expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned.

Applicants believe that no additional fees are required for consideration and entry of this paper. However, Applicants authorize the Director to charge any required fee or credit any overpayment to Deposit Account No. 04-1105, Reference No. 84804(303989).

Respectfully submitted,

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